

REMARKS

In the Office Action mailed September 30, 2003, claims 1-145 were pending.

Within these claims, the Examiner has set forth 8 species as follows:

1. A pharmaceutical formulation wherein an active agent has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle;
2. A pharmaceutical formulation wherein a first active agent has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle and additionally a second active agent that is solubilized or suspended in the vehicle;
3. A pharmaceutical formulation wherein an active agent has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle, which is substantially free of added water;
4. A pharmaceutical formulation comprising an active agent that has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle, wherein the process of preparing the composition involves the step of coating the interfacial agent on the particles;
5. A pharmaceutical formulation comprising an active agent that has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle, wherein the composition further comprises a means for segregating the first and second fractions;
6. A method for reducing the effect of food on absorption and bioavailability of orally administered agent to a patient;
7. A method for increasing the onset of therapeutic effect of an active agent and reducing time to apparent elimination; and
8. A method for reducing the interpatient variability with respect to absorption and bioavailability.

Under 35 U.S.C. 121, the Examiner requires the Applicants to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner has indicated claim 1 to be generic.

The Applicants, without traverse, elect Species 1 drawn to a pharmaceutical formulation wherein an active agent has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle.

Additionally, the amendments to claims 73, 109, and 111 have been made merely to correct the claim dependency for each of these individual claims. Thus, claims 1-145 are currently pending. Accordingly, reconsideration of all claims in light of the amendments, election, and following remarks is respectfully requested.

Species Election Under 35 U.S.C. 121

The Examiner has required the Applicant under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner has additionally indicated claim 1 to be generic.

Before discussing the election, it is thought proper to briefly state what is required for requiring such an election of species. In section 806.04(e) of the MPEP 8th edition, revised February 2003, states:

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).

Additionally, section 806.04(f) of the MPEP states:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

Accordingly, in order for a claim to be properly restricted to a species and separated from claims directed to other species, the claim must recite an embodiment that is mutually exclusive from the other species.

Accordingly, the Applicants, without traverse, elect Species 1 drawn to a pharmaceutical formulation wherein an active agent has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle. Since all present claims contain the element of a pharmaceutical formulation wherein an active agent has a first fraction suspended in a vehicle and a second fraction solubilized in a vehicle, claims 1-145 are readable on Species 1. Therefore, pursuant to the present election, claims

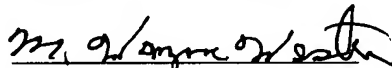
1-145 remain for consideration in the present patent application, and no claims are withdrawn from consideration. Upon allowance of the generic claim 1, Applicants are entitled to consideration of claims to the additional species 2-8.

If any impediment to the entry of the present election and examination of the application remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone Mr. David Osborne or in his absence the undersigned at (801) 566-6633, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 20-100.

Dated this 10 day of FEB., 2004.

Respectfully submitted,


M. Wayne Western
Attorney for Applicant
Registration No. 22,788

Of:

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
8180 South 700 East, Suite 200
Sandy, Utah 84070
(801) 566-6633